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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,853	01/19/2001	William D. Sell	55449USA9A.002	9113

7590 08/13/2004

Attention: Harold C. Knecht III  
Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER
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ROSALES HANNER, MORELLA I

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/766,853

### Applicant(s)

SELL ET AL.

### Examiner

Morella I Rosales-Hanner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/19/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Detailed Action**

1. **Claims 1 – 58** have been examined and are pending.

***Priority***

2. The Office acknowledges Applicant's claim for domestic priority under 35 U.S.C. 119(e) from U.S. Provisional Application No. 60/208,138, filed on May 31<sup>st</sup>, 2000.

***Information Disclosure Statement***

3. The information disclosure statements (IDS) received by the Office on Jan10th, May 21<sup>st</sup> and Jun 26<sup>th</sup> of 2001, are in compliance with the provisions of 37 CFR 1.97. Accordingly, the Examiner has considered the information disclosure statements.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 4.1 The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**4.2 Claims 1 – 15, 19 – 24, 31 – 40, 44 – 58** are rejected under 35 U.S.C.

103(a) as being unpatentable over U.S. Patent **No. 6,414,693** to Berger et al., hereafter referred to as *Berger* in view of a printed publication by Macro Systems, hereafter referred to as *Macro*.

**4.2.1** As regard to **claims 1 - 15, 31 and 40**, *Berger* teaches [Fig 1 and corresponding text] a system for designing a customized artistic element package to be applied to a product comprising:

- a computer apparatus including memory for storing a plurality of product representations in said memory such that a desired one of said product representations may be selected via said input apparatus for viewing on the monitor, said computer apparatus comprising:
  - an operator computer, located at one of a product distributor, the residence of an end user [individual purchaser] and is provided with a browser and being coupled to said input apparatus and said monitor, said customized artistic element package being designed using said operator computer and

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it is capable of receiving one or more customer-generated print files and transmitting said one or more customer-generated print files to said server system [Fig 1, element 110 and corresponding text];

- a server computer system including memory for storing web site information including said plurality of initial artistic element representations and said at least one product representation, said server system being capable of downloading said web site information to said operator computer for viewing by an operator at said monitor, and said operator computer being capable of sending print file information for said order to said server computer system [Fig 1, element 116 and corresponding text]; and
- an artistic elements manufacturer computer system which is capable of being interconnected with said server system, said server system sending said print file information for said order to said artistic elements manufacturer computer system after receiving said print file information

from said operator computer[Fig 1, element 120 and corresponding text].

- input apparatus coupled to said computer apparatus capable of generating appropriate command signals to said computer apparatus to permit one of said selected one or more initial artistic element representations to be moved from a first location to a second location on said product representation [Figs 7 - 9 and corresponding text], and capable of:

- generating appropriate command signals to said computer apparatus to permit one of said one or more initial artistic element representations to be rotated on said product;
- generating appropriate command signals to said computer apparatus to permit at least one of the size and shape of at least one of said selected one or more initial artistic element representations to be modified;
- permitting an order for said artistic element package to be generated and said computer apparatus electronically transmits print file and purchaser identification information for said order to an artistic elements manufacturer;

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- generating appropriate command signals to said computer apparatus to input a request for pricing information for said package prior to generating said order; and
  - permits a product identification number and a distributor [dealer] identification number to be input into said computer apparatus, said vehicle and distributor identification numbers defining said customer [purchaser] identification information[Fig 5 and corresponding text];
- at least one monitor coupled to said computer apparatus for displaying said selected one or more initial artistic element representations placed on said product representation and said initial artistic element representations comprise a plurality of representations of one or more of dimensional graphics and flat graphics;
- said input apparatus further permitting one or more final artistic element representations to be designed with input from a person using said selected one or more initial artistic element representations, said one or more final artistic element representations defining a customized artistic element package;

- said one or more final artistic element representations comprise said one or more initial artistic element representations placed at one or more predefined locations on said product, said initial artistic element representations being located at said one or more predefined locations on said product when initially selected and placed on said product representation [Figs 5 and 7 – 9 and corresponding text].

*Berger* fails to expressly teach a system for designing a customized artistic element package to be applied to a vehicle.

*Macro* teaches

[<http://web.archive.org/web/20000303222506/http://www.macrosystem.com>] unique visualization and multi-media tools that drive accessory and aftermarket product sales that provide comprehensive Dealership and Internet-based solutions and allows dealers to increase their accessory and aftermarket product sales, profits and customer satisfaction by offering customers the exact vehicle and products they want

[<http://web.archive.org/web/20000303222506/http://www.macrosystem.com>].

It would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system for customizing a product over the internet, as taught by *Berger*, with the tools taught by *Macro* to provide internet consumers with the



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capability to configure the exact vehicle they want – including the accessories and aftermarket products that often personalize their products in order to allows dealers to increase their accessory and aftermarket product sales, profits and customer satisfaction by offering customers the exact vehicle and products they want.

**4.3**           **Claims 16 – 18, 25 – 30, and 41 – 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent **No. 6,414,693** to Berger et al., hereafter referred to as *Berger* in view of a printed publication by Macro Systems, hereafter referred to as *Macro*, as applied to claims 1 –15, 19 –24, 31 – 40 and 44 – 58 above, in further view of a printed publication from **MicroStation Manager** by Susan Maclean titled “Wide Format Printing”, hereafter referred to as *MicroStation*.

**4.3.1**       As regard to **claims 16 – 18, 25 – 30, and 41 – 43**, *Berger* teaches [Fig 1 and corresponding text] a system for designing a customized artistic element package or graphic such as sew-on textile patch, a screen-printed design, an adhesive decal or another form of appliqué [Col 1 lines 19 –21], to be applied to a product and wherein the system includes an artistic elements supplier (manufacturer) computer system [Fig 1, element 114]. *Berger* further teaches [Col 3, lines 30 – 58] a supplier server that can be in general a microprocessor-based microcomputer with advance file-serving capabilities connected to a scanner or other input/output peripheral.

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*Berger* does not expressly teach a printed processor, coupled to a printer, for receiving one or more images and generating commands for the printing the receive one or more images on a substrate layer or an apparatus for cutting said graphic substrate to separate one or more finalized artistic elements from a remaining portion of said graphic substrate.

*Macro* teaches [**For Automotive Portals section**] a system that provides Internet consumers with the capability to configure the exact vehicle they want including accessories and aftermarket products that often personalize their vehicle.

*MicroStation* teaches [**Pg 5, Roland CAMMJET section**] the CAMMJET, wide-format printer and contour cutter in one machine, featuring the printing technology of Roland's HI-Fi JET, the CAMMJET has automatic optical registration, allowing a printed image to be removed, laminated and returned to the printer to be contour-cut. *MicroStation* further teaches that applications for the CAMMJET product include posters, labels, decals ad comps packaging, proofing and POP displays.

It would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system for customizing and designing a customized artistic element package or graphic over the internet, as taught by *Berger*, to provide Internet consumers with the capability to configure the exact vehicle they want by including accessories and aftermarket products that often personalize their vehicle as

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taught by *Macro* by connecting the artistic element supplier's machine to a wide-format printer and contour-cutter apparatus for printing images as taught by *MicroStation*.

### ***Additional references***

5. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 5,851,614 to Ronald Mark Buck,
- U.S. Patent No. 5,487,010 to Drake et al.,
- U.S. Patent No. 6,304,855 to Raymond R. Burke,
- U.S. Patent No. 5,880,740 to Halliday et al.,
- U.S. Patent No. 5,559,714 to Banks et al.,
- WFI Government Services, Inc. "HTS Sells Interactive Healthcare Division",
- Lisa Auslen, "Roland Delivers World's First PANTONE Hexachrome® Calibrated Printer", Pantone 1998 press release,
- Tim Keenan, "Toyota gets set to start the e-business parts revolution", April 2000, WARD'S Dealer Business,
- Ford Motor Company, "Fords Unveils Interactive Strategy", Jan 12, 1999,
- CNNMoney, "Automakers in B2B pacts", January 13, 2000,
- William J. Holstein, "The Dot Com Within Ford", U.S. NEWS & World Report, Feb 07, 2000

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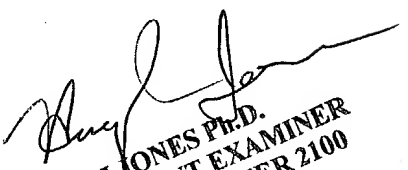
6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Morella Rosales-Hanner whose telephone number is (703) 305-8883. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jean Homere can be reached on (703) 308-6647. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MRH

August 5th, 2004

  
HUGH JONES Ph.D.  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2100